

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-3 and 5-12 are pending in this application, Claims 11 and 12 having been added; and Claims 1, 5, and 7-10 having been presently amended. Support for amended Claims 1, 5, and 7-10, and new Claims 11 and 12 can be found, for example, in the original claims, drawings, and specification as originally filed. No new matter has been added.

In the outstanding Office Action, Claims 8-10 were rejected under 35 U.S.C. § 101; Claims 1-3 and 5-10 were rejected under 35 U.S.C. § 112, second paragraph; and Claims 1-3, 5, 6, and 8-10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ginter et al. (U.S. Patent No. 6,253,193; hereinafter “Ginter”) in view of Hughes (U.S. Patent No. 6,748,537) and Matsuyama et al. (U.S. Patent Publication No. 2002/0026581; hereinafter “Matsuyama”).

Applicants acknowledge with appreciation the courtesy of Examiner Su in granting an interview in this case with Applicants’ representative on July 16, 2009, during which time the issues in the outstanding Office Action were discussed as substantially summarized hereinafter and also on the Interview Summary Sheet. No agreement was reached during the interview pending a formal response to the outstanding Office Action.

In regard to the rejection of Claims 8-10 under 35 U.S.C. § 101, page 2 of the outstanding Office Action asserts that method recited in Claim 8 is not tied to a particular machine or apparatus and is thus nonstatutory based on *In re Bilski*. In response, Applicants have amended Claim 8 to more clearly be directed towards statutory subject matter. Page 3 of the outstanding Office Action asserts that Claim 8 is non-statutory “because there is insufficient tie to a machine or structure for all the limitations in the body of the claim. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.” Initially, Applicants note that in order

to be statutory under 35 U.S.C. § 101 the claimed process must either be tied to a particular machine or apparatus or transform the underlying subject matter to a different state or thing. Thus, the test can be fulfilled in two ways, there are not two requirements that need to be met, but rather just one.

Applicants respectfully submit that the method recited in amended Claim 8 is tied to a particular machine or apparatus, as Claim 8 recites that the information processing method is implemented by an information processing apparatus, and recites that a processor in the information processing apparatus performs an authentication process with the first execution file. Thus, the method recited in Claim 1 is tied to a particular apparatus.

Page 3 of the outstanding Office Action also asserted that Claim 8 fails the *Bilski* test because there is insufficient tie to a machine or structure *for all the limitations* in the body of the claim. However, Applicants respectfully submit that there is no such requirement that was set forth in the test in *In re Bilski*. As described above, *In re Bilski* only requires that for a method to be statutory under 35 U.S.C. § 101 the claimed process must either be tied to a particular machine or apparatus or transform the underlying subject matter to a different state or thing.

Accordingly, Applicants respectfully request that the rejection of Claims 8-10 under 35 U.S.C. § 101 be withdrawn.

In response to the rejection of Claims 1-3 and 5-10 under 35 U.S.C. § 112, second paragraph, with respect to Claim 1, page 4 of the outstanding Office Action states that “Applicant recites ‘computer-readable storage medium’ in an attempt to claim the system. However, much of the claim is directed to functions of the file and what the file does. The limitations of the body of the claim is inconsistent with what Applicants has set forth to claim in the preamble.” However, Applicants note that the preamble is not inconsistent with the body of the claim, as Claim 1 is directed to a computer-readable storage medium, and the

body of the claim recites information that is recorded on the computer-readable storage medium.

Page 4 of the outstanding Office Action also objects to the means-plus-function language recited in Claim 1. In response, Applicants have amended Claim 1 to remove the means-plus-function terminology. Page 5 of the outstanding Office Action asserts that there is insufficient antecedent basis for the term “encrypted content” at line 13 of Claim 1, however Applicants note that line 13 of Claim 1 contains the first instance of the term “encrypted content” and thus no antecedent basis is necessary because this is the first time this term is used. A similar argument is made for Claims 5, 7, and 8. With respect to the term “the decrypted content” in line 14 of Claim 1, Applicants note that the antecedent basis for the term “the decrypted content” is found in line 13 of Claim 1, which describes “decrypts encrypted content using the content key.” Thus, the decrypted content in line 14 refers to the encrypted content that is decrypted in line 13 of Claim 1. In regard to the term “digital signature information attached to said content” in the line 16 of Claim 1, Applicants note that this claim does not require antecedent basis as this is the first recitation of the term “digital signature information.” A similar argument is made for Claims 5, 7, and 8.

Lastly, in regard to the other informalities noted in the outstanding Office Action with respect to Claims 1-3 and 5-10, Applicants have amended these claims to correct the noted informalities set forth in the outstanding Office Action.

Accordingly, Applicants respectfully request that the rejection of Claims 1-3 and 5-10 under 35 U.S.C. § 112, second paragraph be withdrawn.

In response to the rejection of Claims 1-3, 5, 6, and 8-10 under 35 U.S.C. § 103(a) as unpatentable over Ginter in view of Hughes and Matsuyama, Applicants respectfully submit that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 1 is directed to a computer-readable storage medium including, *inter alia*:

...a first execution file recorded on said computer-readable storage medium using a copy protection mechanism, said first execution file including

instructions for performing an authentication process with a second execution file,

instructions for obtaining unique key information unique to said first execution file, and

instructions for transmitting said unique key information to said second execution file,

wherein the instructions in said first execution file are executed by an information processing apparatus including a processor, when said computer-readable storage medium is inserted into said information processing apparatus and said second execution file generates a content key from said transmitted unique key information, decrypts encrypted content using the content key, and reproduces the decrypted content, and

wherein said encrypted content is recorded on said computer-readable storage medium and said unique key information is configured to encrypt encryption key information for encrypting digital signature information attached to said encrypted content, and said instructions for transmitting cause said encrypted content to said second execution file based on said digital signature information.

Independent Claims 5 and 8 recite substantially similar features as independent Claim

1. Thus, the arguments presented below with respect to independent Claim 1 are also applicable to independent Claims 5 and 8.

Page 13 of the outstanding Office Action asserts that Ginter describes a computer-readable storage medium including “a first (i.e. PPE A, see Ginter, Column 218, Lines 33-38) execution file (i.e., contain executable code, see Ginter, Column 86, Lines 36-48) recorded on said computer-readable storage medium (i.e. stored in CD-ROM, see Ginter, Column 62, Line 43 to Column 63, Line 17) using the copy protection mechanism (i.e. rights protection

mechanism, see Ginter, Column 2, Line 61 to Column 3, Line 9).” However, Ginter describes that the PPE A is a protected processing environment, and does not describe that the PPE A is a first execution file. The PPE A appears to be a hardware device and not an execution file.¹ In addition, Ginter does not describe that the PPE A is stored on a CD-ROM. Thus, Ginter fails to teach or suggest “a first execution file recorded on said computer-readable storage medium using a copy protection mechanism,” as recited in Claim 1.

Ginter also does not describe that the PPE A is executed by an information processing apparatus including a processor, when the computer-readable storage medium storing the PPE A is inserted into the information processing apparatus, as in Applicants’ Claim 1. Further, Applicants respectfully submit that Hughes and Matsuyama fail to cure any of the above-noted deficiencies of Ginter.

Page 16 of the outstanding Office Action states that “while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swinehart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). The limitation ‘wherein said first execution file is executed by an information processing apparatus...and said transmitting means transmits said content to said second execution file based on said digital signature information’ is not given patentable weight for the purpose of prior art examination.”

Thus, the outstanding Action appears to assert that features of the claimed invention can be ignored as being “functional,” in other words that the function cannot be relied upon to distinguish the prior art based on language found in MPEP §2114. However, the case law cited in this section as well as other controlling precedent does not support the conclusion

¹ See column 105, line 23 to column 107, line 30; column 218, line 33-37; and column 217, line 35-38 of the specification; and Figure 13.

that a claimed function can be ignored. In this regard, *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ 2d 1429, 1431-32 (Fed. Cir. 1999) (cited as authority in the noted MPEP §2114) does not support any theory that functional limitations can be ignored, rather this case requires that a reference structure used to reject a claim structure defined by what it does must inherently perform the claimed function. In this regard, it is well established that inherency requires the certainty that something will happen, not merely a possibility or even a probability that something may occur. See *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) and *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981).

Again note the further discussion of functional limitations in MPEP §2173.05(g) that specifically treats the *Swinehart* decision (*In re Swinehart* 439 F.2d 210, 169 USPQ 226 (CCPA 1971)) mentioned in MPEP §2114 as noting that functional limitations defining structure by the function performed by that structure are valid claim limitations that this section instructs “must be evaluated and considered, just like any other limitation of the claim”

Accordingly, Applicants respectfully submit that all features recited in the claims should be considered and given their full meaning.

Page 16 of the outstanding Office Action also states that Claim 1 contains limitations “representative of nonfunctional descriptive material as the instructions are not functionally related to the structure of the claimed invention. See MPEP §2106.01; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). This limitation is not given patentable weight for the purpose of prior art examination.” However, as *In re Gulack* relates to descriptive material presented on a substrate, *In re Gulack* is wholly unrelated to the Applicants’ claims. The nonfunctional descriptive written material distinguished in *In re Gulack* is only deemed nonfunctional as it relates to the patentability of a substrate. Simply stated, this case makes it clear that what is written on a substrate will not distinguish the invention from the prior art in terms of

patentability of the substrate. It is unclear why the Official Action cites this case as a first execution file including instructions for performing an authentication process with a second execution file is not written material. Applicants' claimed first execution file including instructions for performing an authentication process with a second execution file is in stark contrast to a mere font of typeface, as discussed in the cited case law. Accordingly, Applicants submit that this rejection is deficient, and should be withdrawn, at least, for this reason alone.

Applicants respectfully submit that independent Claims 1, 5, and 8 (and all claims depending thereon) patentably distinguish over Ginter, Hughes, and Matsuyama.

Accordingly, Applicants respectfully request that the rejection of Claims 1-3, 5, 6, and 8-10 under 35 U.S.C. § 103(a) as unpatentable over Ginter in view of Hughes and Matsuyama be withdrawn.

In order to vary the scope of protection recited in the claims, new Claims 11 and 12 are added. New Claims 11 and 12 find non-limiting support in the disclosure as originally filed, for example at page 9, lines 5-18.


Therefore, the changes to the claims are not believed to raise a question of new matter.²

² See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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